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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/708,233	11/08/2000	Robert L. Hudkins	CEPH-1157	1416

7590 11/07/2003

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EXAMINER

KIFLE, BRUCK

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 11/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/708,233

Applicant(s)

HUDKINS ET AL.

Examiner

Bruck Kifle, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Applicant's amendments and remarks filed 8/18/03 have been received and reviewed.

Claims 1-5 are now pending in this application.

Claim Rejections - 35 USC § 112

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

ii) The term "substituted" throughout the claims without saying which substituents are intended is indefinite. One skilled in the art cannot say which substituents are permitted and which ones are not. Applicants point to the specification.

iii) The term "heteroaryl" is indefinite because it is not known how many atoms are present, how many and what kind of heteroatoms are involved, what size ring is intended and how many rings are present. Applicants point to the specification.

iv) The term "heterocyclic" is indefinite because it is not known how many atoms make up the ring, which atoms are present and what kind of a ring (monocyclic, bicyclic, spiro, fused, bridged, saturated, etc.) is intended. Applicants point to the specification.

Applicants are reminded that although the claims are interpreted in light of the specification, critical limitations from the specification cannot be read into the claims (see, e.g., *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Ded. Cir. 1991)). Accordingly, without the recitation of all these critical limitations, the claims do not adequately define the instant invention.

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vi) In the definition of $\text{NR}^{23}\text{R}^{24}$ as "the residue of an α -amino acid in which the hydroxy group of the carboxyl group is excluded" it is unclear which amino acids are intended. Incorporation into the claims of the amino acids intended would obviate this rejection.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-5 are again rejected under 35 U.S.C. 102(b) as being anticipated by Lewis et al. (US 5,461,146). The claims read on the compounds on table 1 (see previously sent CAS abstract and structures). The claims read on, for example, the compound II-47 which has the RN 121665-11-0 (which corresponds to the instant compounds wherein in the instant case R^1 represents $-\text{CH}_2\text{OR}^{44}$; R^2 , W_1 and W_2 are H; X represents a loweralkoxycarbonyl and Y is hydroxy).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-5 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis et al. (US 5,461,146). The reference teaches structurally similar compounds (see table 1, columns 5-10). See, for example, compound II-30. In this reference compound R^1 represents $-\text{CH}_2\text{SC}_2\text{H}_5$ (corresponding to instant R^1 as $-(\text{CH}_2)_k\text{R}^7$, k being 2 and R^7 as $\text{SR}^{27\text{B}}$ and $\text{R}^{27\text{B}}$ is unsubstituted lower alkyl); R^2 is H (corresponding to instant R^2 as hydrogen); X is CO_2CH_3 (corresponding to instant X as lower alkoxy carbonyl); R is $-\text{OH}$ (corresponding to instant Y as hydroxy) and Z^1/Z^2 are hydrogen (corresponding to instant W_1 and W_2 as hydrogen). The claims differ by requiring a two-carbon linker over the one carbon linker when one of R^1 or R^2 represents $-(\text{CH}_2)_k\text{R}^7$. That is,

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instant "k" is 2 whereas in the reference it is 1. It has been long established that structural relationship varying the size of a linking carbon chain - is per se obvious. Specifically, In re Shetty, 195 USPQ 753, In re Wilder, 195 USPQ 426 and Ex Parte Gresham 121 USPQ 422 all feature a compound with a C₂ link rejected over a compound with a C₁ link. Similarly, In re Chupp, 2 USPQ 2nd 1437 and In re Coes, 81 USPQ 369 have a C₁ link unpatentable over a C₂ link. Ex parte Ruddy 121 USPQ 427 has a C₃ link unpatentable over a C₁ link. Ex parte Nathan, 121 USPQ 349 found the insertion of a C₂H₄ link obvious. In all of these cases, the variation was per-se obvious and did not require a specific teaching.

Double Patenting

Claims 1-5 are again rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,306,849. The basis of this rejection is the same as given in the previous office action and is incorporated herein fully by reference.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle, Ph.D. whose telephone number is 703-305-4484. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund J. Shah can be reached on 703-308-4716. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Bruck Kifle, Ph.D.
Primary Examiner
Art Unit 1624

BK
November 4, 2003